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Petition to make  
PATENT Special

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Roger M. Snow                      Examiner:                      Unknown  
Serial No. 09/740,216                      Group Art Unit:                      3713  
Filed: December 18, 2000                      Docket No.                      PA0513.ap.US  
Title: METHOD OF PLAYING A THREE PART WAGERING GAME

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on January 3, 2002.

Mark A. Litman  
Name

  
Signature

**PETITION TO MAKE EXAMINATION SPECIAL UNDER  
UNDER 37 C.F.R. §1.102(d)**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

This is a Petition in accordance with 37 C.F.R. 1.102(d) to make examination and prosecution of the above identified application, U.S. Patent Application Serial No. 09/740,216, filed December 18, 2000 (hereinafter the "Application"). **The required fee for this petition under 37 C.F.R. 1.17(i), in the amount of \$130.00, is authorized to be withdrawn from Deposit Account Number 50-1391.**

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EVIDENCE OF INFRINGEMENT

The basis for this petition is belief by Applicant and the assignee of this Application and their legal counsel that existing claims in the Application are being infringed by a product that has been offered for sale in the United States. Counsel for Applicant has read claims of the Application on the product that is believed to be infringed by the claims of the Application, and the product appears to literally infringe the claims of that Application and claims that can be drafted based on the disclosure in that specification. The basis of the belief that a game offered

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for sale may infringe claims in the Application or that can be drawn in the Application is at least a published article in gaming Today, October 16, 2001 (hereinafter the "Article").

Assignee of the Application (Shuffle Master, Inc.) has a game in the marketplace that is encompassed by the claims of the Application, and that game is marketed under the name of "TRIPLE SHOT." A competitor, D.P. Stud, is described in the Article as distributing THREE WAY ACTION®, which is described below in comparison with assignee's TRIPLE SHOT.

<b>THREE WAY ACTION</b>	<b>TRIPLE SHOT and APPLICATION DISCLOSURE</b>
Three segment wagering game	Three segment wagering game
All three segments played against a dealer	All three segments played against a dealer
A first segment is 'War,' initially a single card game, where highest card wins.	A first segment is 'War,' initially a single card game, where highest card wins.
Players then get additional cards to play 21	Players then get additional cards to play 21
Players then get additional cards, up to a total of 7 cards, and play 5-card poker hands	Players then get additional cards, up to a total of 7 cards, and play 5-card poker hands
Minor variations in play may be available, such as maximizing the number of cards in the play of 21, but the article is silent on that.	The specification of the Application allows for variations in play.

In addition to a comparison between the games, the following claims have been added by Preliminary Amendment contemporaneously with the filing of this Petition:

21. (New) A method of playing a three segment wagering game comprising the steps of:
- A player placing three wagers to participate in three sequentially played game segments;
  - A dealer dealing a first card to each player and to the dealer and paying the player when a rank of the player's card exceeds a rank of the dealer card;
  - A dealer dealing at least one additional card to each player and the dealer, and paying the player when a combined point total of his hand comprising the first card and the at least one additional card exceeds a point total of the dealer's hand without exceeding 21;

A dealer dealing additional cards, if necessary, to each player to provide at least an amount of cards needed to form a poker-type hand, and wherein the player's hand ranking is compared to a predetermined hierarchy of winning poker-type hands and a payout awarded when the player achieves one of the predetermined winning hands.

- 22. (New) The method of claim 21, wherein each wager is equal.
- 23. (New) The method of claim 21, wherein a total number of cards dealt in the 21 game does not exceed 6.
- 24. (New) The method of claim 21, wherein each predetermined winning hand is a five card combination.
- 25. (New) The method of claim 24, wherein each player receives six cards, and the player's five card hand is formed from the best 5 of the 6 cards.
- 26. (New) The method of claim 21, wherein the 21 game is played according to conventional blackjack rules.

As can be readily seen from a comparison of these claims and the play of the THREE WAY ACTION® game, the play of that game would literally infringe some of the claims reproduced above.

#### PRESENTATION OF ALL CLAIMS TO A SINGLE INVENTION

All claims in the Application, both the original claims and the claims added by amendment, are method claims directed towards a single invention. In the event that the US Patent and Trademark Office determines that multiple inventions are present, Applicant, through his attorney, will make a telephonic election of what the Examiner identifies as a single invention, including at least all newly submitted claims, 21-27.

## STATEMENT OF A PRE-EXAMINATION SEARCH

A database pre-examination search has been made by key-word search according to M.P.E.P. Section 708.02, section VIII, C and E, and the below signed counsel has reviewed files and prior art collections in his possession to determine the most relevant art. All relevant art found was classified in or referenced to Class 273, subclass 293. The below signed counsel has also made a manual search in November of 2001 in class 273, subclass 293 and found no additional relevant prior art. All relevant art found is described below, with the closest prior art, in the opinion of below signed counsel, being U.S. Patent No. 5,988,643 (Awada).

## PRE-EXAMINATION SEARCH RESULTS

### Deatiled Discussion of the References in Accordance with 37 C.F.R. 1.111(b) and (c) Hedman U. S. Patent 6,179,293

This reference describes a combination poker and blackjack game, the poker and blackjack games being played with the same 5 cards. Players place three mandatory bets to play blackjack high hand, blackjack low hand and poker high hand. The house randomizes and distributes eight hands of five cards each. A random selection process is used to select the dealer. An optional poker jackpot bet can also be made. The player's first set their poker hand. The highest poker hand (dealer or players) wins the poker bet. Players and the dealer then take the same cards, and set their high 21 hand and their low 21 hand. All high hands beating the dealer's high hand win a payout. All low hands beating the dealer's low hand win a payout. The jackpot payout is paid to the player (or dealer) with the highest ranking poker hand.

This process and game are distinguished from the claims of the present application by at least the fact that:

- a) in the game of the Application, cards are dealt one at-a-time, a high card (single card game) is played (which is not shown in Hedman et al.),
- b) cards may not be rearranged for the play of 21 or blackjack but are dealt in the conventional manner,
- c) Hedman et al. deals out all cards used in play, so that players see all cards at the beginning of the game.

These steps do not anticipate or suggest play of the game claimed in the Application.

#### Awada U.S. Patent 5,988,643

A game play method is described that has three mandatory game segments. All three segments are played against the dealer. The player makes three equal bets to participate in a game of high card, blackjack and poker, in that order. The player and dealer are dealt a first card face up, and the high card wager is resolved. The players then receive an additional card face up, and the dealer takes one more card face down. Players and the dealer may take up to five additional cards to play blackjack. Standard blackjack rules apply, except that the maximum number of cards in the blackjack hand is 7, and players may not double down. At the conclusion of the blackjack game, the dealer then deals himself and each player additional cards until all participants hold seven cards. The players set their best five-card poker hand and must beat the ranking of the dealer's hand to win.

The game of this patent substantively differs from the claimed invention of the Application at least by the fact that in Awada et al., the poker bet is not resolved against a pay table. The Awada et al. Patent does not disclose the limitation recited in claim 26 that

“...player's hand ranking is compared to a predetermined hierarchy of winning poker-type hands and a payout awarded when the player achieves one of the predetermined winning hands...”

#### Awada U.S. Patent 5,921,550

A three segment wagering game is described in which the player has three mandatory game segments that are played against the house, and not a dealer. After placing three wagers, the dealer deals a first card to the player. If the rank of the first card is a 9 or higher, the player wins the first wager. The dealer then deals a second card to each player. If the rank of the second card is 9 or higher, or the first two cards are a pair of 2's-8's, the player wins the second wager. The dealer then deals three additional cards to form a five-card poker hand. Poker hands are resolved against a pay table that identifies predetermined winning combinations and corresponding payout odds.

This game substantively differs from the claimed invention of the Application at least in the fact that:

- a) the first game played with a single card does not compete with the dealer;

- b) the second game played is not equivalent to 21 or blackjack, but is essentially 2-card poker;
- c) the final player hand consists of five cards and only those five cards may be used in the play of a poker game; and
- d) no games are played against a dealer.

#### Hedman U.S. Patent 5,678,821

The game play method described in this patent is substantially identical to what is described in Hedman U.S. Patent 6,179,293, except for the following differences. The player need not place all three bets, but it is preferable that the high/low 21 bets and poker bet are mandatory. The 21 games are played before the poker hands are played. Winning poker payouts are made against a schedule of eligible winning hands, or against a dealer hand. When the player is playing poker against the dealer, in order to give the house more of an advantage, the players must have a minimum qualifying hand in order to receive a payout. The bonus poker hand preferably pays a progressive payout according to a schedule of eligible winning hands.

This process and game are distinguished from the claims of the present application by at least the fact that:

- d) in the game of the Application, cards are dealt one at-a-time, a high card (single card game) is played (which is not shown in Hedman et al.),
- e) cards may not be rearranged for the play of 21 or blackjack but are dealt in the conventional manner,
- f) Hedman et al. deals out all cards used in play, so that players see all cards at the beginning of the game.

These steps do not anticipate or suggest play of the game claimed in the Application.

#### Macaixa U.S. Patent 5,639,092

This reference describes a multiple segment casino-style game with various betting options. Players may select one or more games to play (in a single round) from the group of: blackjack, roulette, baccarat, poker and a jackpot bet. The player can make between one and five bets.

To begin play, each player and the dealer receive two cards. The dealer has one up card and one hole card. The roulette bet is resolved first. If the player placed the

roulette bet, the dealer wins if the player holds a red and black card or has a point total of 12. Otherwise, the player wins. The players then have the option of receiving up to three additional cards. Simultaneous games of blackjack and poker are then played. If the player's hand count after the third card exceeds 21 and his hand has a lower poker ranking than three of a kind, the dealer takes the 21, poker and bonus bets. The player then has the option of taking a fourth card. If his hand exceeds 21 and his hand is lower than a three of a kind in poker ranking, the dealer takes the 21, poker and jackpot bet. The player then has the option of taking a fifth card. If his hand count exceeds 21, and his poker hand is less than three of a kind, the 21, poker and jackpot bets are taken by the dealer. The dealer reveals his hole card, and then takes hits until his hand is a hard 17 or higher. If the dealer busts, the players are paid on the blackjack wager only. If the player beats the dealer on the 21 hand, the player wins the 21 bet. If the player has a predetermined winning poker combination, he wins the poker bet. Winning poker combinations are listed on a pay table. If the player has one of a subset of the winning combinations, he wins the bonus bet.

This game substantively differs from the claims of the Application in that the Macaisa et al. game requires that

- a) 2 cards be initially dealt to the player and dealer; the first displayed card is used in a roulette-type wager, with the suit matching the color on a roulette spin;
- b) there is no equivalent to a player versus dealer high card game (e.g., War);
- c) wagers are resolved with each sequential card dependent upon the value of a player's hand; and
- d) busting of a dealer's blackjack hand terminates the blackjack hand and stops play on the poker game.

These are substantial differences that prevent the Macaisa et al. reference from anticipating the claims of the Application or providing a substantial teaching that would impact the obviousness of the claims of the Application.

#### Malek U.S. Patent 5,395,120

The casino game described in this reference allows a player to play draw poker against the dealer, and 21 (or baccarat) against other players. The poker bet (against the dealer) is

mandatory, while the 21 or baccarat bet (against the other players) is optional. At least two players must place a bet to participate in the 21 (or baccarat) game. The 21 game bet is made into a player pot, rather than to the house.

The dealer deals five cards to each player and the dealer. The player can view the dealer's (single) up card, as well as his own cards and decide whether to fold or make an additional bet. The dealer then deals two additional cards to himself and each player, that are used in combination with the other five cards to make the best five card hand. The other two cards are used to set a two card 21 hand. If the 21 bet was not placed, two cards are discarded. Each poker hand is played against the dealer hand. The 21 hands are settled by comparing the hands of each player and paying the player with the highest hand a payout. The cards used to play the 21 hand are not used to play the poker hand, and visa versa.

In the play of this game, even though there is a single card exposed for both the player and the dealer, the card is not used in a game of war, but is used only to provide information to influence the play of the player.

#### Josephs U.S. Patent 5,377,993

This patent describes a modified 21 game followed by a poker segment. The player places a wager, and both the players and dealer are dealt 2 cards each. Only the dealer takes additional cards as required by the conventional rules of 21. The player is allowed to view his two cards and the up card of the dealer and decide whether or not to increase his bet. If he does not increase his bet, he plays only the 21 game. If he increases his bet, he also participates in a 4 card poker game at the conclusion of the 21 game. The 21 game is resolved first. Then, the first two dealer cards are combined with the player's 2 cards to form a 4-card poker hand. The poker game pays according to a payout table. The payout table identifies winning hands and corresponding payout odds. Players decide whether or not to place the additional bet after they have seen their two cards and the dealer's up card.

This game does not provide a single card to the player and dealer to use in a high card competition, but requires the deal of two cards to immediately initiate a blackjack game. Only a four-card poker game is played in continuing the play of the blackjack game.



These are substantial differences that prevent the Malek reference from anticipating the claims of the Application or providing a substantial teaching that would impact the obviousness of the claims of the Application.

Cabot et al. U.S. Patent 5,322,295

This patent describes a casino wagering game wherein a player makes multiple wagers to simultaneously play multiple hands of the same game (preferably blackjack). Each player is provided with an initial partial hand of at least one card for each wager placed. The dealer supplies supplemental cards, and the player is allowed to select the hand assignment for each card. The object of the game in one form of the invention is to obtain a predetermined point count, such as a 21, for example. In this form, the player is playing for a point total, and is not competing with the dealer. In another form of the game, the dealer deals himself a hand of cards, and the player's hand must beat the dealer's hand without exceeding a point total of 21.

There is no initial game of war, and there is no poker play. These are substantial differences that prevent the reference from anticipating the claims of the Application or providing a substantial teaching that would impact the obviousness of the claims of the Application.

Malek U.S. Patent 5,265,882

A casino-style card game is described with multiple game segments. Players must play (in a single round) at least two of three games against the dealer and other players. The games are 21, modified draw poker and Baccarat. The table layout includes card positions at each player station for a 2 card 21 hand, a five card poker hand and a 2 card baccarat hand. Each player position on the layout also includes a three spot betting area for the house, and a three spot betting area for the player. The player must place at least two bets against the house on at least two of the three games. The dealer and player are dealt one card, the player cards being dealt face up. The player with the highest ranking card may optionally place bets against other players, but only for games he is betting against the house. If he passes, the player with the second (then third) highest ranking card can place the bet. The dealer deals the player the number of cards needed to play the games bet on, and deals himself a number of cards needed to play against the games in play. For example, if player 2 was playing only 21 and baccarat, but player 1 was

playing all three games, the dealer would deal himself 9 cards total. Hands against the house are resolved first. The games against the other players are resolved last.

There is no game played with a single card being initially dealt, and there is no pay table for poker hands to be resolved at the end of play. These are substantial differences that prevent the Malek reference from anticipating the claims of the Application or providing a substantial teaching that would impact the obviousness of the claims of the Application.

Boylan et al., U.S. Patent Nos. 5,098,107; 5,257,877; and 5,265,877

A method and apparatus for playing a wagering game include a usual play of the game whose outcome is determined by a selection of usual randomly generated symbols. Added to the usual symbols is at least one and preferably a plurality of additional, preferably no-value, symbols. The wagering game is then played by wagering on the usual play of the game and additionally by wagering on a chance occurrence of one and preferably at least two of the additional symbols being selected during the usual play. The wages on the chance occurrence are settled according to the outcome of the chance occurrence, and the usual wagers are similarly settled depending on the outcome of the usual play of the game. In one preferred embodiment, the wagering game is a usual card game so that the usual chance generated symbols are a deck of value playing cards. The additional symbols are then at least two no value playing cards that are added to the deck. In other embodiments, the usual symbols are representations of such cards, numbers, or other symbols of significance. Besides dealing of the symbols, the use of ball and grid selection devices, an electronic selection device with a video display, or a lottery mixing and picking device are possible. Preferably, the generated symbols are representations of a deck of value playing cards and a display means represents the dealing of the represented cards on the video display screen. Representative games would be 21, poker, baccarat, and pai gow.

There is no disclosure of the play of an initial high card (single card) competition between the player and the dealer, and there is no pay table for resolution of hands of predetermined value. These are substantial differences that prevent the Boylan et al. reference from anticipating the claims of the Application or providing a substantial teaching that would impact the obviousness of the claims of the Application.

**CONCLUSION**

Based upon the above analysis, there is a clear issue of potential infringement of claims in the Application. There is no art that has been found in a pre-examination search that anticipates the claims proposed for prosecution in the Application, so there appears to be a likelihood that a patent will issue having claims that will encompass the potentially infringing product.

Copies of all references determined to be relevant to an examination of this Application have been provided.

Applicants believe that they have established that expedited Examination of the Application is warranted, justified, and evidenced.

Respectfully submitted,

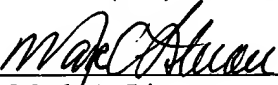
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